

REMARKS

Claims 1-17 have been examined on their merits.

Claims 2, 4, 5, 6, 7, 9, 10, 12 and 13 have been editorially amended for reasons of precision of language. The amendments to claims 2, 4, 5, 6, 7, 9, 10, 12 and 13 were made merely to more accurately claim the present invention, were not made for reasons of patentability and thus do not implicate an estoppel in the application of the doctrine of equivalents.

Claims 1-17 are all the claims presently pending in the application.

1. 1. Claims 1-3, 7-10, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cheng (U.S. Patent No. 5,563,883). Applicant traverses the rejection of claims 1, 2, 6-9 and 13 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Cheng fails to teach or suggest a method that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, wherein the predetermined number of virtual identities for signaling are independent of the true identities of a plurality of remote units, as recited in claim 1. Cheng discloses, *inter alia*, that errors have to be processed in the event of message collision. *See, e.g.*, col. 9, line 66 to col. 10, line 26 of Cheng. Contrary to the present invention (in which the virtual identities bear no relation to the actual identity of the remote units), Cheng has to process collision errors that might result from two remote terminals having the same identification value. Figure 9 of Cheng discloses a field (TID) that specifically identifies a particular terminal. As shown in Figure 12a, a selective ranging process must be carried out when there is a collision due to multiple remote terminals having the same identification value. The Patent Office appears to be making the argument that inclusion of the remote terminal serial number in the signaling action type field (SAT) for channel assignment is somehow related to the virtual identities generated by the fixed unit. This is quite different from the present invention, wherein a remote unit that needs to communicate with the fixed unit selects a virtual identity (if available) to transmit the signaling message, and virtual identity has an identity that is independent from the actual identity of the remote unit.

Based on the foregoing reasons, Applicant submits that Cheng fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Cheng clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claims 2, 3 and 7 are

allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 102(b) rejection of claims 1-3 and 7.

With respect to claim 8, Cheng fails to teach or suggest a system that comprises a first controller means that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, wherein the predetermined number of virtual identities for signaling are independent of the true identities of a plurality of remote units, as recited in claim 8. For at least the same reasons as discussed above with respect to claim 1, Applicant submits that there is no disclosure in Cheng of a means that increases and/or decreases a predetermined number of virtual identities, which are independent of the true identities of the remote units, based on an occupancy level of signaling multiframe.

Based on the foregoing reasons, Applicant submits that Cheng fails to teach or suggest all of the claimed elements as arranged in claim 8. Therefore, under *Hybritech* and *Richardson*, Cheng clearly cannot anticipate the present invention as recited in independent claim 8. Thus, Applicant submits that claim 8 is allowable, and further submits that claims 9, 10, 14 and 15 are allowable as well, at least by virtue of their dependency from claim 8. Applicants respectfully request that the Examiner withdraw the § 102(b) rejection of claims 8-10, 14 and 15.

2. Claims 4-6, 11-13, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cheng in view of Grauel *et al.* (U.S. Patent No. 4,573,206). Applicant traverses the rejection of claims 4-6, 11-13, 16 and 17 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the

USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Claims 4-6 depend from claim 1, and therefore include all the recitations of claim 1 by virtue of their dependency.

The combination of Cheng and Grauel *et al.* fails to teach or suggest a method that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, wherein the predetermined number of virtual identities for signaling are independent of the true identities of a plurality of remote units, as recited in claim 1 and included via dependency in claims 3-5. As discussed above with respect to claim 1, Cheng lacks any disclosure with respect to varying the number of virtual identities for signaling based on occupancy or the generation of virtual identities that are independent of the true identities of a plurality of remote units. Grauel *et al.* discloses the reassignment of group codes to control the amount of traffic, but Grauel *et al.* does not teach or suggest varying the number of virtual identities for signaling based on occupancy levels, or the independence of the virtual identities. *See, e.g.*, col. 2, lines 35-50 of Grauel *et al.* Thus, Applicant submits that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicant submits that one of ordinary skill in the art would not be motivated to combine the two references. Both Cheng and Grauel *et al.* lack any teaching about the desirability of increasing and/or decreasing a predetermined number of independent virtual identities due to occupancy levels. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Cheng and Grauel *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claims 4-6. Therefore, the combination of Cheng and Grauel *et al.* clearly cannot render the present invention obvious as recited in claims 4-6, and Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 4-6.

Claims 11-13, 16 and 17 depend from claim 8, and therefore include all the recitations of claim 8 by virtue of their dependency.

The combination of Cheng and Grauel *et al.* fails to teach or suggest a device with a first controller means that increases or/and decreases a predetermined number of virtual identities for signaling based on the level of occupancy of a signaling multiframe, wherein the predetermined number of virtual identities for signaling are independent of the true identities of a plurality of remote units, as recited in claim 8 and included via dependency in claims 11-13, 16 and 17. As discussed above with respect to claim 8, Cheng lacks any disclosure with respect to a device for varying the number of virtual identities for signaling based on occupancy, as well as the independence of the virtual identities from the true identities of the plurality of remote units. As discussed above with respect to claims 4-6, Grauel *et al.* discloses the reassignment of group

codes to control the amount of traffic, but Grauel *et al.* does not teach or suggest varying the number of independent virtual identities for signaling based on occupancy levels. *See, e.g.*, col. 2, lines 35-50 of Grauel *et al.* Thus, Applicant submits that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicant submits that one of ordinary skill in the art would not be motivated to combine the two references. As noted above, both Cheng and Grauel *et al.* lack any teaching about the desirability of increasing and/or decreasing a predetermined number of independent virtual identities due to occupancy levels. Thus, Applicant submits that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

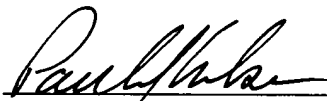
Based on the foregoing reasons, Applicant submits that the combination of Cheng and Grauel *et al.* fails to disclose all of the claimed elements as arranged in claim 8, and included via dependency in claims 11-13, 16 and 17. Therefore, the combination of Cheng and Grauel *et al.* clearly cannot render the present invention obvious as recited in claims 11-13, 16 and 17, and Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of claims 11-13, 16 and 17.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. APPLN. NO. 09/598,896
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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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